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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/964,488	09/28/2001	Jean-Louis H. Gueret	08048.0014-00	2767
7590	04/05/2005			EXAMINER
Thomas L. Irving FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER, L.L.P. 1300 I Street, N.W. Washington, DC 20005-3315			MANAHAN, TODD E	
			ART UNIT	PAPER NUMBER
			3732	
			DATE MAILED: 04/05/2005	

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/964,488	GUERET, JEAN-LOUIS H.	
	Examiner	Art Unit	
	Todd E. Manahan	3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 13 January 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-36,38-91,93-146 and 148-175 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) 7-9,36,45-56,62-64,91,99-110,117-119,146 and 155-166 is/are allowed.
- 6) Claim(s) 1-6,10-11,13-26,28-35,38-44,57-61,65-66,68-81,83-90,93-98,11-116,120-121,123-136,138-145,148-154,167-175 is/are rejected.
- 7) Claim(s) 12,27,67,82,122 and 137 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 102

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-6, 11, 13-26, 28-35, 38-44, 57-61, 66, 68-81, 83-90, 93-98, 111-116, 121, 123-136, 138-145, 148-154, 173-175 are rejected under 35 U.S.C. 102(e) as being anticipated by Dumler et al. (United States Patent No. 6,158,913).

Dumler et al. disclose a device for applying a product, the device comprising a receptacle body 2 defining a reservoir 4 containing a product, an application element 7 configured to apply a product to a surface; a cavity in flow communication with the reservoir and configured to receive the application element (see figure 2), and a support element on which the application element is mounted, wherein the support element is mounted to pivot relative to the receptacle body between a first position wherein the application element is received in the cavity and a second position wherein the application element is at least partially exposed so as to be capable of coming into contact with a surface to which product is to be applied, wherein the application element is configured to apply product to at least one of skin, hair, toenails, and fingernails, and wherein the reservoir contains a product chosen from at least one of a skin product, a hair product, a toenail product and/or a fingernail product. The receptacle body is configured to be used as a handle for holding the device during application of product to the surface. The support element is configured to close and hermetically seal the cavity when the support element is in the first position. The support element is configured to pivot over an angle of at least approximately 120 degrees. The device further comprises a hinge member associated with the support element,

the support element being configured to pivot about the hinge member. The device further comprises a head portion 10 associated with the receptacle body, wherein the hinge member connects the support element to the head portion. As clearly shown in figure 3, the applicator “remains external to the reservoir” and thus is deemed to be so configured. Regarding claims 173-175, product from the reservoir could load onto the applicator while the applicator is in the cavity” and thus the device is deemed to be so configured.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 10, 65 and 120 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cloud (United States Patent No. 5,348,031) in view of Cai (United States Patent No. 6,450,720).

Cloud discloses the invention essentially as claimed except for the application element being made of foam instead of a sintered material (see col. 4, lines 28-33). Cai discloses an application element made of foam, felt sponge or sintered particles, thus demonstrating that foam and sintered material are functional equivalent porous structures in the art. Therefore, it would have been obvious to one skilled in the art to substitute a sintered material for the foam applicator of Cloud in view of Cai, as such would be nothing more than substitution of functional equivalents known in the art. Regarding claims 167-172, product placed in the reservoir could

load onto the applicator positioned in the cavity and thus the device is deemed to be so configured.

Allowable Subject Matter

Claims 7-9, 36, 45-56, 62-64, 91, 99-110, 117-119, 146, 155-166 are allowed.

Claims 12, 27, 67, 82, 122, 137 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments filed 13 January 2995 have been fully considered but they are not persuasive.

In response to applicant's arguments that Dumler et al. "fails to disclose or otherwise suggest that 'the application element is configured to remain external to the reservoir'", applicants attention is directed to figure 3 which clearly shows the applicator element of Dumler et. al. remaining external to the reservoir.

In response to applicant's arguments that Dumler et. al. "fails to disclose or otherwise suggest that a device (sic) 'configured to load at least a portion of the application element with product from the reservoir while the application element is positioned in the cavity'", it is noted that when the application element is in the cavity as shown in figure 2, product from the reservoir may flow into the cavity and onto the applicator. As such, the device of Dumler et al. is configured to load at least a portion of the application element with product from the reservoir while the application element is positioned in the cavity.

In response to applicant's arguments that because Cloud discloses a cosmetic applicator for skin products and Cai discloses an applicator for hair products, one skilled in the art would not find foam and sintered material functional equivalents in the art, it is noted that cosmetic products and hair products are applied by similar applicators. In fact as set forth in the instant application, the application of hair products and skin products can use the same type of applicator (note applicant's Markush claims). Cai clearly sets forth the equivalence of foam and sintered material in the manufacture of applicators of personal care products and thus one skilled in the art would find it obvious to substitute sintered material for foam in the applicator of Cloud. Gueret (United States Patent No. 5,895,162) and Bennett (United States Patent No. 5,538,022) were previously cited as additional examples that it is known in the prior art to make a cosmetic applicator of sintered material.

In response to applicant's arguments that "at least some of the dependent claims recite unique features and combinations that are neither taught nor suggested by the cited art and therefore at least some are separately patentable" such arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Todd E. Manahan whose telephone number is 571 272- 4713. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached on 571 273-4720. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Todd E. Manahan
Primary Examiner

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T.E. Manahan
1 April 2005